

REMARKS

Claims 1-9 are pending in the application. Claims 1-9 stand rejected. Claims 1-9 are amended. Claims 10-30 are new. No new subject matter is added. Claims 1-30 are now pending in the application. In light of the above amendments and the following remarks, reconsideration and allowance of the pending claims is respectfully requested.

Statement of Common Ownership

Tseng constitutes prior art under 35 U.S.C. 102(e) as of its earliest U.S. filing date, or 15 March 2002. *See* MPEP § 2136. The filing dates of foreign applications may not be used as 35 U.S.C. 102(e) dates for prior art purposes. *See* MPEP § 2136.03, emphasis in original.

Tseng does not constitute prior art under any one of 35 U.S.C. 102(a), (b), (c), or (d). *See* MPEP §§ 2132, 2133, 2134 and 2135. Thus, Tseng qualifies as prior art only under 35 U.S.C. 102(e), (f), or (g).

According to 35 U.S.C. 103(c), subject matter developed by another which qualifies as prior art only under 35 U.S.C. 102(e), (f), or (g) may be disqualified as prior art against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” *See* MPEP §§ 706.02(l)(1) and 2146.

As of the filing date of the present application, the present application and Tseng had the same assignee, namely, Veutron Corporation. Consequently, Tseng is disqualified as prior art for purposes of a 35 U.S.C. 103 rejection. *See* 35 U.S.C. 103(c).

The applicant therefore requests that the rejections of claims 1-9 under 35 U.S.C. 103(a) as being unpatentable over Tseng be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 1-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,198,845 (Tse) in view of U.S. Patent No. 5,321,501 (Swanson et al.) and further in view of U.S. Patent No. 7,126,728 (Tseng). The applicant traverses the rejections.

As discussed above, Tseng is disqualified as prior art for the purposes of a 35 U.S.C. 103 rejection, and so the following arguments will be directed to the remaining references, Tse and Swanson.

Regarding claims 1, 4, and 7, the claims recite “scanning a longitudinal white pattern” and/or “a longitudinal black pattern.” The Office Action acknowledges that Tse does not teach this feature, but then proposes that Swanson teaches this feature at “Figures 8A-8C, col 14, lines 44-67 & col 15, lines 1-8.” *See* Office Action page 3. The applicant respectfully disagrees that Swanson teaches a longitudinal black and/or white pattern. Specifically, Swanson teaches a pattern of scanning; not an element that is a pattern. The cited portion of Swanson states:

As was discussed earlier, a typical scan pattern for the various embodiments of the invention is for the probe assembly to be positioned at a selected transverse position with respect to the sample and mechanism 46 or other longitudinal scanning mechanism discussed in conjunction with FIGS. 1A-1B to be operated to complete the longitudinal or depth scan at the given transverse position. The transverse position is then altered in a manner, for example, described in conjunction with FIGS. 2-7 and a depth scan is completed at the new transverse position. This process is repeated until scanning has been performed at all desired transverse positions. This is the scan pattern illustrated in FIG. 8A.

See Swanson col. 14, lines 44-56. This portion of Swanson makes clear that Swanson is using the word ‘pattern’ to refer to a method of scanning, not to an element of a scanner. Therefore, the ‘pattern’ of Swanson cannot correspond to the longitudinal black and/or white pattern recited in the claims.

Claims 1, 4, and 7, also recite “determining correctional gray level values for complete black” and/or “complete white” “based on the longitudinal patterns.” The Office Action proposes that Tse teaches this feature at “Figures 6 & 7, col 5, lines 8-26.” *See* Office Action page 3. The applicant respectfully disagrees. Figures 6 and 7 of Tse are a histogram and a graph, respectively, of the gray levels of an image of the input document. *See* Tse col. 5, lines 8-14. The cited portion of Tse does not contain any teachings about correctional gray level values for complete black or complete white. Also, since Tse does not teach longitudinal patterns (as acknowledged in the Office Action), the applicant submits that the disclosure of Tse could not contain any teachings about correctional gray level values based on longitudinal patterns. Therefore, Tse does not teach correctional gray level values for complete black and/or complete white based on longitudinal patterns as recited in the claims. The disclosure of Swanson does not remedy this deficiency of Tse.

For at least the reasons identified above, claims 1, 4, and 7 are allowable over the combination of Tse and Swanson as the combination does not teach all of the features recited in the claims. Dependent claims 2, 3, 5, 6, 8, and 9 are likewise allowable.

Further regarding claims 3, 6, and 9, the claims recite “calculating a compensational gray level value using correctional gray level values for black” and/or “white” and “theoretical gray level values for black” and/or “white.” The Office Action proposes that Tse teaches these features because it discloses “flowcharts, equations and formula to calculate correction grey level value, equations 2-19.” Even if equations 17, 18, and 19 of Tse teach calculations for determining an adjusted pixel grey-level value, these equations do not teach using the features recited in claims 3, 6, and 9 to make the calculations. Tse’s equations use the maximum dynamic range of its system ($Z_{MAX} - Z_{MIN}$), image reflectance values from an input document (R_{MAX} , R_{MIN}), the input document background grey level (BKG), and/or the reflectance of white paper as determined by a scanner calibration process (white). *See* Tse col. 6, line 31 to col. 7, line 65. None of these equations uses a correctional gray level value for black and/or white based on a longitudinal pattern or a theoretical gray level value for black and/or white. Therefore, Tse does not teach the calculation recited in the claims. Swanson does not teach this type of calculation and thus does not remedy the deficiency of Tse. For at least this additional reason, claims 3, 6, and 9 are allowable over the combination of Tse and Swanson.

New Claims

New claims 10-17 and 19-23 are fully supported by the application as filed at, e.g., original claims 1-9, FIG. 2, and Specification paragraphs [0015-0020].

New claims 25-29 are fully supported by the application as filed at, e.g., original claims 1-9, FIGS. 3-5, and Specification paragraphs [0017-0020].

New claims 18, 24, and 30 are fully supported by the application as filed at, e.g., FIG. 2 and Specification paragraph [0016].

The applicant submits that the new claims include several features that are not taught in Tse and Swanson or any possible combination of the two including at least: a reference pattern; black and white correction gray level values; theoretical gray level values; and a reference

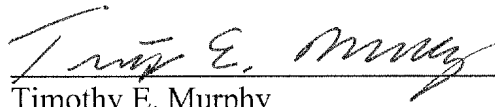
pattern equal to or longer than a scanning platform. Therefore, the applicant submits that new claims 10-36 are allowable over the combination of Tse and Swanson.

CONCLUSION

For the foregoing reasons, reconsideration and allowance of all pending claims is requested. The Examiner is encouraged to telephone the undersigned at 503-222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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A handwritten signature in cursive script, appearing to read "Timothy E. Murphy", is written over a horizontal line.

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